

REMARKS

Status of Claims

Claims 1, 3, 6-7 and 11, 13-15 are pending, of which claim 1 is an active independent claim. Claims 2, 4-5, 8-10 and 12 have been cancelled without prejudice. Claims 1 and 13 have been amended to more clearly define the intended subject matter. Support for the amendment is found, for example, at paragraph [0036] of the present specification. Care has been taken to avoid introducing new matter.

Claim Rejection – 35 U.S.C. § 112

Claim 12 has been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Since claim 12 has been cancelled, the rejection of 35 U.S.C. 112 is moot.

Claim Rejection – 35 U.S.C. § 102

Claims 1, 3 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshiko (JP-2004-039832). This rejection is traversed for at least the following reasons.

First, Applicants respectfully submit that Yoshiko fails to disclose “the isolation region being made of a *silicon film*,” as recited by claim 1. The Examiner asserts that the silicon oxide of Yoshiko corresponds to the claimed silicon film in broadest reasonable interpretation.

However, M.P.E.P. § 2111 clearly states:

During patent examination, the pending claims must be “given their broadest reasonable interpretation **consistent with the specification.**” [] *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “**in light of the specification as it**

would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004).

The broadest reasonable interpretation of the claims must also **be consistent with the interpretation that those skilled in the art would reach.** *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (*Emphasis added*).

The present specification discloses that the isolation region 3, 14 is filled with the same material as the silicon substrate 1 (see, paragraph [0050]) and may or may not contain impurities (see, paragraph [0045]). Thus, it is apparent that the term “silicon film” should be interpreted, in light of the specification as it would be interpreted by one of ordinary skill in the art, a semiconductor silicon, but not silicon dioxide. One of ordinary skill in the art would not construe the term “silicon film” as film comprising silicon. It should be noted that since the meaning of a silicon film is clear, it is not necessary to further define this term in the claims.

Second, Applicants respectfully submit that Yoshiko fails to disclose the claimed second silicon film which has a smaller impurity concentration than that of the first silicon, as recited by claim 1. The Examiner asserts that the inner portion of layer 6 and the outer portion of layer 6 of Yoshiko correspond to the claimed first and second silicon layer. However, since the layer 6 of Yoshiko is made of the same p-type silicon, the inner portion and the outer portion do not have different impurity concentrations. As such, it is clear that Yoshiko fails to disclose the second silicon layer as recited by claim 1.

Accordingly, Applicants respectfully submit that Claim 1 and all claims dependent thereon are patentable over Yoshiko. Thus, it is requested that the Examiner withdraw the rejection of claims 1, 3 and 13 under 35 U.S.C. § 102(b).

Claim Rejection – 35 U.S.C. § 103

Claims 1, 3, 6-7, 11 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshiko in view of Mouli (U.S. Patent No. 7,492,027). Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshiko in view of Mouli as applied to claim 1, and further in view of Zehavi et al. (U.S. Patent No. 6,583,377). This rejection is traversed for at least the following reasons.

Applicants incorporate herein the arguments previously advanced in traversal of the rejection under 35 U.S.C. § 102(b) predicated upon Yoshiko. Applicants respectfully submit that the additional cited references do not teach or suggest the second silicon layer which has a smaller impurity concentration than that of the first silicon as recited by amended claim 1, which is missing from Yoshiko. Therefore, any combination of Yoshiko with Mouli or Zehavi would still fail to disclose the claimed feature, and it would not have been obvious to add this feature to any such combination. Accordingly, claim 1 and all claims dependent thereon are patentable over the cited references. Thus, it is requested that the Examiner withdraw the rejection of claims 1, 3, 6-7, 11 and 13 under 35 U.S.C. § 103(a).

New Claim

Since new claims 14 and 15 depend upon claim 1, these claims are patentable for at least the same reasons as claim 1. Further, none of the cited references disclose the elements of claims 14 and 15, these claims are is patentable on their own merit in addition to the dependency upon claim 1.


CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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